

### **REMARKS**

Claims 75 and 78-83 remain in the application for further prosecution. Claims 75 and 82 have been amended. Claims 1-74 and 76-77 have been canceled.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 75-83 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Raven et al. (U.S. Patent No. 5,429,361) in view of Sizer et al. (U.S. Patent No. 5,923,252). Applicant respectfully traverses the rejection of claim 83 and submits that the pending claims are patentable over the Raven-Sizer combination.

**Claim 75** has been amended as follows:

75. (Currently Amended) A method of operating a gaming machine, comprising:  
detecting the presence of a passerby proximate to the gaming machine, the passerby not playing the gaming machine, the detecting including establishing a wireless transmission link between a first wireless transceiver in the gaming machine and a second wireless transceiver disposed in a portable data unit carried by the passerby, the portable data unit including information for allowing an identity of the passerby to be determined; and  
in response to detecting the presence of the passerby, modifying operation of the gaming machine; and  
receiving an input at the gaming machine from the passerby, the input being associated with a wagering game.

**Claim 83** provides as follows:

83. (Currently Amended) A method of operating a gaming machine, comprising:  
detecting the presence of a passerby proximate to the gaming machine, the passerby not interacting with the gaming machine; and  
in response to the detecting, modifying the operation of the gaming machine based on information wirelessly communicated between a portable data unit carried by the passerby and the

gaming machine, wherein the modifying includes inviting the passerby to interact with the gaming machine ~~by placing a wager on a game playable on the gaming machine[.]; and~~

receiving at the gaming machine a signal indicative of a wager on a game playable by the passerby on the gaming machine.

Amended claim 75 includes limitations from dependent claims 76-77, which have been canceled. Applicants submit that amended claims 75 and 83 are patentable over the Raven-Sizer combination.

A distinction between Sizer and claim 75 as amended is that claim 75 calls for the modifying operation of the gaming machine, and receiving a wagering-game input at the gaming machine. No such disclosure is found in Sizer. Likewise, Sizer does not disclose or suggest inviting the passerby to **interact with** the gaming machine or **receiving at the gaming machine a signal** indicative of a wager on a game playable by the passerby on the gaming machine, as called for by claim 83.

Sizer states that “Smart” Cards or RF cards carried by the person may contain “demographic and psychographic information on the person and this information could be used by the device to select messages **for delivery.**” Col. 6, ll. 11-15. Sizer goes on to state: “When the person approaches a device in accordance with the present invention, it is detected by the device and it is determined in accordance with the process of FIG. 3 that **a message is to be delivered**, in controlling message delivery, the microcomputer can take into account information obtained from the RF card, to personalize the message, or to address the message to a particular subject which it is apparent from the RF card information, the person is interested in.” Col. 16, ll. 24-32. In other words, the **message delivery** device 1 is just that—a passive device that *delivers* messages only. Nowhere does Sizer disclose or suggest that the message delivery device 1 can receive anything (let alone a wager) from the person whose presence is detected by the device 1. The device 1 simply broadcasts an audio or visual message to the detected person, and in no way invites that person to interact with the device itself. On Page 4 of the Office Action, the Examiner asserts that “Sizer discloses inviting the passerby to interact with the machine.” **Applicants strongly disagree with**

**this statement.** Sizer does not disclose the passerby's interacting or playing with "the machine," *i.e.*, the message delivery device 1.

The Office Action admits of this distinction as stated on page 3: "Sizer's system is directed at the attracting a passerby to interact with **point-of-sale devices** and storing information tracking their interaction." Office Action at 3. The point-of-sale devices in Sizer do not detect the presence of a passerby, do not receive a wagering-game input from the passerby or a signal indicative of a wager, and do not establish a wireless transmission link between the point-of-sale device and a portable data unit carried by a passerby. This is a reason why the Examiner's attempt to analogize Sizer's marketing system to Applicants' claimed invention fails. As Applicants have pointed out in a prior response, **a person detected by Sizer's message delivery device 1 in no way whatsoever interacts with that device 1.** Therefore, the device 1 cannot be considered analogous to the claimed gaming machine to which the passerby is invited to play and which receives a wager from the detected passerby. Nor can the point-of-sale devices be considered analogous to the claimed gaming machine because the point-of-sale devices do not detect the presence of a passerby, do not receive an input from a passerby, and do not establish a wireless transmission link between the point-of-sale device and a portable data unit carried by a passerby. Moreover, in the RF ID Card embodiment described in Sizer at column 16, lines 14-32, no point-of-sale devices are mentioned. Rather, the device 1 delivers a message "to a *particular subject* which it is apparent from the RF card information, the person is interested in." There are no point-of-sale devices mentioned in the only embodiment described in Sizer pertaining to RF ID Cards and Smart Cards. With regard to the other embodiments, Sizer does not disclose the passerby carrying a portable data unit that wirelessly transceivers information with a gaming machine. Moreover, in these other embodiments, the passerby in no way interacts with, is invited to play with, or inserts a wager into the point-of-sale products described in Sizer. These products include a "particular brand of wine" (*id.*, col. 2, ll. 39-51; col. 4, ll. 1-12), "products available for purchase within the petrol station" (*id.*, col. 5, ll. 18-19), "a particular exhibit" at a museum or art gallery (*id.*, col. 5, ll. 26), "a safety message" warning a person standing on the edge of a train platform (*id.*, col. 5, ll. 27-30), or at a pedestrian intersection or in loiter-free places (col. 5, ll. 30-34).

Simply put, Sizer is directed to a fundamentally different marketing system than that employed in a casino environment with gaming machines.

In addition, Sizer does not disclose a wireless *transceiver* on a portable data unit or a gaming machine. The message delivery device 1 can “detect and read” RF ID Cards and Smart Cards, col. 16, ll. 14-32, but no embodiment is disclosed in Sizer for bidirectional communication between the message delivery device and RF/smart card.

Raven et al. does not disclose at least: (1) detecting the presence of a passerby proximate to the gaming machine, the passerby not playing the gaming machine; (2) establishing a wireless transmission link between a first wireless transceiver in the gaming machine and a second wireless transceiver disposed in a portable data unit carried by the passerby, the portable data unit including information for allowing an identity of the passerby to be determined; (3) in response to the detecting modifying operation of the gaming machine; or (4) in response to the detecting, inviting the passerby to interact with the gaming machine.

The Examiner states that that the machine of Raven “offers a game suggests inviting the passerby to play the machine.” Office Action at 5. However, the claim calls for *in response to the detecting, modifying* operation of the gaming machine (based on information wirelessly communicated between a portable data unit carried by the passerby and the gaming machine as called for by claim 83). Indeed, the gaming machine in Raven is incapable of inviting a passerby to play the gaming machine in response to detecting a passerby, *the passerby not playing the gaming machine*. It is not until the player inserts a card into the gaming machine that the gaming machine in Raven is “aware” that a player intends to play a game. Col. 7, ll. 51-53. There is no prior detection of the player in Raven before the player interacts with the gaming machine, and therefore the skilled artisan would find no inspiration in Raven to arrive at Applicants’ invention. Even if the wired communication in Raven were modified to be a wireless communication (a modification that is not suggested by Raven because Raven actually teaches away from Applicants’ claimed invention, as discussed below), such a modified Raven system would still not meet the limitation of, *inter alia*, inviting the passerby to play the gaming machine or interact with the gaming machine.

The Office Action does not address Applicants' arguments submitted in their previous response, supported by citations to *Raven et al.*, that *Raven et al. teaches away* from Applicants' invention. Such evidence of "teaching away" constitutes potent evidence of nonobviousness. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 U.S.P.Q.2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 U.S.P.Q. 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198 U.S.P.Q. 344 (C.C.P.A. 1978). *Raven et al.* suffers from precisely the drawback clearly identified in Applicants' Background of the Invention section, cited in response to the previous Office Action, which Applicants' invention sought to overcome:

**Heretofore, to communicate with gaming machines, portable data units of the above type have had to be manually inserted by players into data unit readers at the gaming machines. This arrangement suffers from numerous drawbacks.** First, the process of retrieving the portable data unit and manually inserting it into a data unit reader can be inconvenient to a player especially if the player wishes to play numerous gaming machines in a relatively short period of time. Second, unless the portable data unit is somehow attached to the player by a string, chain, or the like, a player may forget to remove the portable data unit from the data unit reader upon completion of a gaming session, thereby possibly allowing a subsequent unscrupulous player at that gaming machine to use the data unit for his/her own benefit. Third, data unit readers are often disposed at peculiar locations on gaming machines, such as above a video or mechanical display. This, in turn, requires a player to awkwardly reach for the peculiar location to manually insert the portable data unit. If the portable data unit is attached to a string or the like, it is common for the string to hang over and partially obscure the machine display as the player plays the gaming machine.

Page 2, line 21 to page 3, line 2 (emphasis added).

As the Examiner is aware, *Raven et al.* must be considered in its entirety, including portions that would lead one skilled in the art away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, *supra*. With that being said, the Examiner must consider the following numerous statements in *Raven et al.* that teach *repeatedly* that the DMK 12 receives a card that is *inserted* into the DMK 12 reader, the precise problem that Applicants' invention sought to overcome. See, e.g., Abstract ("The control unit can accept personality data from a card *inserted* into the card reader"); Claim 7 ("said transmitting means accepts said personality data from a card

*inserted* into said card reader”); Claim 10 (“wherein the player is identified by a card *inserted* in said card reader and said card is reinserted to reactivate the gaming machine”); Claim 11 (“said control means is responsive to a card *inserted* in said card reader”); Claim 15 (“cashless means which responds to a credit card *inserted* into said card reader”); col. 3, ll. 38-39 (“Once an employee card has been *inserted* into the card reader 34”); col. 4, ll. 45-47 (“the countdown resets to this value when a different player card is *inserted* into the card reader”); col. 4, ll. 62-64 (“The DMK 12 receives three types of input data: card data read from a card *inserted* by either a player or employee”); col. 6, ll. 46-47 (“The magnetic card reader 48 accepts bit stream data from an *inserted* magnetic card”); col. 7, ll. 51 (“After the player *inserts* his card containing good data); col. 8, ll. 35-37 (“The reservation mode may also be canceled by *insertion* of an employee card into the card reader 34”); col. 8, ll. 41-42 (“A valid employee card *inserted* into the card reader 34”); col. 9, ll. 40-41 (“To enter this mode, the employee will *insert* his card”); col. 10, ll. 49 (“The player *inserts* his magnetic card into the magnetic 48 or combined magnetic/smart 34 card reader in the DMK 12”); col. 11, ll. 30-31 (“The player *inserts* the card into the smart 46 or combined smart/magnetic card 34 reader”); col. 10, ll. 60-62 (“the player must request a transfer of credits from the system each time he *inserts* his magnetic card”).

As a result, Applicants submit that one of ordinary skill in the art would find no inspiration whatsoever in Raven et al. for modifying it to incorporate the wireless features as claimed. The combination of Raven et al. (which discloses wired instead of wireless data systems) and Sizer et al. (which does not disclose a gaming machine) actually teaches away from their combination, and therefore they cannot be combined to reject Applicants’ claims.

Moreover, modification of Raven et al. to include wireless functionality would fundamentally change the principle of the operation of the wired system and would require a substantial reconstruction and redesign of the teachings of Raven et al. Nearly all of the hardware and software components disclosed in Raven et al. would have to be substantially modified in order to adapt the wired system to the claimed wireless systems and methods. Substantial redesign to arrive at a claimed invention is also potent evidence of non-obviousness.

The combination of Raven and Sizer is also improper because Raven and Sizer relate to non-analogous arts. For a reference to be considered “analogous,” the reference must “either be within the field of applicant’s endeavor or, if not, then must be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). A reference is “reasonably pertinent” if it “would have logically commended itself to an inventor’s attention in considering his problem.” *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993). Here, Sizer relates to a passive marketing device with which a customer *in no way* interacts, which broadcasts messages to passers-by to induce them to purchase products in the vicinity of the marketing device.

The test for determining whether a reference is “reasonably pertinent” is *not* whether the reference may have been considered analogous to the inventor. Instead, the test for determining whether a reference is “reasonably pertinent” is whether the reference would have *logically* commended itself to some other potential inventor’s (*i.e.*, some other person) attention in considering the problem faced by the present inventors. It is submitted that Sizer would not have logically commended itself to an inventor of the claimed systems and methods.

The Examiner must approach the obviousness issue from the view-point of one using ordinary skill in the art who is not an innovator but follows conventional wisdom. In other words, a person of ordinary skill in the art, seeking to solve a problem of communicating with a gaming machine over a wireless link for such purposes as cashless gaming, player tracking, game customization, and data transfer, would not have reasonably been motivated to look to a reference relating to an audio/visual device for delivering messages for marketing purposes. *See In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1993). It is *immaterial* that the inventor himself arrived at the claimed combination of elements.

Further, the classifications of the applied references is evidence of non-obviousness that must be considered by the Examiner. **Sizer** is primarily classified under **Int. Cl. G08B 23/00**, entitled “Signaling or Calling Systems; Order Telegraphs; Alarm Systems,” subpart 00 relating to “alarms responsive to unspecified undesired or abnormal conditions.” In contrast, **Raven** is primarily classified under **Int. Cl. A63F 9/24**, titled “Card, Board, or Roulette Games; Indoor

Games Using Small Moving Playing Bodies; Miscellaneous Games,” subpart 24 relating to “games using electronic circuits not otherwise provided for.” There is absolutely no overlap or commonality in the classifications of these references or in the fields of search considered relevant by examiners prosecuting these applications. This constitutes evidence of non-obviousness.

For at least the foregoing reasons, Sizer is non-analogous art to the problem at hand, and therefore is not an appropriate prior-art reference to be used for an obviousness-type rejection for any of the pending claims. The customer in no way interacts with the message delivery device 1 of Sizer et al. nor would a customer interact with the inanimate retail products (*e.g.*, wine bottles) associated with the message delivery device 1. Customers engaged by Sizer’s marketing device are not lured to purchase or interact with the message delivery device 1; rather they are engaged to purchase the point-of-sale products in the vicinity of the message delivery device 1. By contrast, according to Applicants’ invention, players are invited to interact with or play the gaming machine itself. In this respect, Applicants’ invention differs significantly from the marketing device in that the customers of Sizer’s marketing device *in no way interact with it* nor are invited to interact or play with it.

The analogy created by the Office Action can be summarized in the following table:

<b>Sizer et al.</b>	<b>Applicant’s Invention</b>
Customer	Player
Message delivery device 1	????
Point-of-sale products	Gaming machine

The problem with the above analogy is as follows. If the message delivery device is analogous to a gaming machine, then the Office Action’s point about how a casino is merely a specialized type of retail establishment where the POS devices are gaming machines misses the mark. If the POS products are analogous to the gaming machine, then the Examiner has failed to explain the role of the message delivery device in the analogy. The crux of the problem lies in the



fact that Sizer et al. is directed to different types of retail environments than a casino. In the retail environments described in Sizer, the customers are marketed to via the message delivery device that attracts them to the nearby POS products, and, if interested, they purchase the POS product. In a casino, the players are marketed by the gaming machines themselves, and, if interested, they purchase a wager on the gaming machine itself. In this respect, Sizer et al. is also non-analogous art to Applicants' invention, because Sizer et al. relates to a fundamentally different type of marketing system than is applicable to a casino environment.

It is well settled that there must be some motivation that would have led one of ordinary skill in the art to combine references or modify references to arrive at the claimed invention. *See, e.g., B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, **the showing must be clear and particular**. *See, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). Broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993). "The factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). It must be based on **objective evidence of record**. *In re Sang-Su Lee*, 277 F.3d 1338, 1345-46 (Fed. Cir. 2001); *see also In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002).

In *In re Sang-Su Lee, supra*, the court admonished the Board of Patent Appeals and Interferences for failing to perform a "thorough and searching" factual inquiry in its reliance on the Examiner's "conclusory statements," emphasized that "determination of patentability must be based on evidence," and stated that the Board "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims." *In re Sang-Su Lee*, 277 F.3d at 1345-46.

In view of this overwhelming precedent setting forth the evidentiary requirements for setting forth a *prima facie* case of obviousness under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner's stated motivation for combining Sizer's marketing system and Raven's manually inserted card system (*i.e.*, "to add the feature of detecting the presence of a passerby proximate to the gaming machine, the passerby not playing the gaming machine and modifying the operation of the gaming machine in response to detecting the presence of the passerby," Office Action. p. 4) is wholly conclusory (as it simply mirrors Applicants' claim language) and fails to satisfy the evidentiary requirements for establishing a *prima facie* case of obviousness.

The well-established case law mandates the Applicants should not be left to guess as to the Examiner's position on the alleged motivation for combining Sizer and Raven. Without question, the Examiner has failed to **clearly** and **particularly** show that Sizer and Raven teach or suggest reasons why a skilled artisan, **and with no knowledge of the claimed invention**, would select the wireless features of Sizer's fundamentally different marketing system and add them to Raven's manual card system. There is simply no cognizable suggestion or motivation in either reference to make the proffered combination. Indeed, as discussed above, Raven teaches away from modifying the hard-wired connections into wireless links. Neither Sizer nor Raven teach or suggest detecting a passerby via a wireless transmission link in a gaming machine and in response thereto modifying the operation of the gaming machine.

The **only** teaching of this combination is found within **Applicant's disclosure**. Any reliance on Applicant's disclosure to support the rejection is improper. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure."); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

The legal concept of *prima facie* obviousness is a procedural tool of patent examination, allocating the burdens of going forward with production of evidence in each step of the examination

process. *See, e.g.*, MPEP § 2142. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

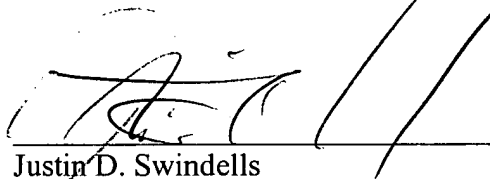
Because the Office Action failed to clearly and particularly show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from Raven and Sizer for combination in the manner claimed, Applicants respectfully submit that the pending claims are allowable thereover.

For at least the foregoing reasons, Applicant respectfully submits that the present independent claims 75 and 83 and their respective dependent claims are patentable in view of Raven over Sizer and are in condition for allowance.

#### **Conclusion**

It is believed that no additional fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00107USD2.

Respectfully submitted,



Justin D. Swindells  
Reg. No. 48,733  
JENKENS & GILCHRIST, P.C.  
225 West Washington Street, Suite 2600  
Chicago, Illinois 60606-3418  
(312) 425-3900 (telephone)  
(312) 425-3909 (telecopy)

ATTORNEYS FOR APPLICANTS

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